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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/466,271	12/17/1999	IAN M. DRYSDALE	FDC-0135-PUS	9967

22045 7590 03/25/2003

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EXAMINER

KANOF, PEDRO R

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 03/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/466,271

Applicant(s)

DRYSDALE, IAN M.

Examiner

Pedro R. Kanof

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 21 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification, as originally filed, does not provide support for the invention as is now claimed, i.e., “the web server processes the transaction without proprietary software.” More specifically, the specification, as originally filed, states that “the web server includes commands for processing the transaction;” but does not disclose that “the web server processes the transaction without proprietary software.”

3. Claim 21 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The rejected claim recites “the web server processes the transaction without proprietary software.” However, it is not clear how transactions performed by using different merchant

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service providers (e.g., American Express, VISA, Master, Discover, etc.) can be completed without respective providers proprietary software.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 5-15, and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muftic

(U.S. Patent No. 5,850,442).

Claims 1 and 12: Muftic discloses a service terminal and a method of performing a card transaction, the method comprising:

accessing a web server using a transaction device, wherein the web server includes commands for processing the transaction (Col. 9, lines 15-55); and

entering a transaction card into a card reader of the transaction device in order to enter transaction information associated with the card into the web server (Col. 10, lines 23-55).

Muftic does not explicitly disclose that the transaction device/the point of service terminal does not utilize proprietary software of a merchant service provider to complete the transaction.

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However, Muftic clearly discloses that one of the advantages of the invention is “to permit world wide electronic commercial transactions to be implemented in a highly secure manner **over an open network**.” (Col. 5, lines 38-41, emphasis added. Thus, it would have been within the level of ordinary skill in the art to install proprietary software to a merchant service provider server “to permit world wide electronic commercial transactions” by using transaction devices/point of service terminals “**over an open network**”. Further, in this configuration, the transaction devices/point of service terminals would not utilize proprietary software of a merchant service provider to complete the transaction.

Claim 2: Muftic discloses the method of claim 1 wherein accessing a web server comprises accessing a web page of the web server, and wherein the web page includes commands for processing the transaction (Col. 10, line 56-col. 12, line 4).

Claim 11: Muftic discloses a method of performing a card transaction, the method comprising:

accessing a web server using a point of service terminal having a web browser and a card reader, wherein the web server includes commands for obtaining authorization of the transaction (Col. 9, lines 15-55, Col. 10, lines 23-55, and col. 12, lines 39-58);

entering a transaction card into the card reader in order to enter an account number associated with the card into the web server and responding to prompts generated by the web server using the terminal (Col. 12, line 53-col. 14, line 19); and

obtaining authorization for the transaction through the web server (col. 12, lines 39-58);

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wherein the point of service terminal does not utilize proprietary software of a merchant service provider to complete the transaction.

Muftic does not explicitly disclose that the point of service terminal does not utilize proprietary software of a merchant service provider to complete the transaction. However, Muftic clearly discloses that one of the advantages of the invention is “to permit world wide electronic commercial transactions to be implemented in a highly secure manner **over an open network.**” (Col. 5, lines 38-41, emphasis added. Thus, it would have been within the level of ordinary skill in the art to install proprietary software to a merchant service provider server “to permit world wide electronic commercial transactions” by using transaction devices/point of service terminals “**over an open network**”. Further, in this configuration, the point of service terminals would not utilize proprietary software of a merchant service provider to complete the transaction.

Claims 3 and 13: Muftic discloses a service terminal and a method of claims 1 and 12. Muftic also discloses entering additional transaction information into the web server (Col.13, line 11-col.16, line 40).

Claim 6: Muftic discloses the method of claim 1. Muftic also discloses the displaying information on a display device of the transaction device (Col. 18, line 11-col.19, line 49).

Claims 7, 8 and 15: Muftic discloses the terminal and the method of claims 6 and 12. Muftic also discloses the displaying information includes displaying an electronic coupon and an advertisement downloaded from the Internet (Col. 20, line 19-col. 21, line 17)

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Claims 9 and 10: Muftic discloses the method of claim 1. Muftic also discloses obtaining authorization for the transaction through the web server and updating the commands of the web server(Col. 12, line 5-col. 14, line 62).

Claims 5 and 14: Muftic discloses the terminal and the method of claims 3 and 14 wherein entering additional transaction information. However, Muftic does not specifically disclose entering the additional transaction information using a keypad of the transaction device. Official Notice is taken that it is old and well known within the computers art to use a keypad of the transaction device (see Microsoft Computer Dictionary, p335). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a keypad of the transaction device. One would have been motivated to use a keypad in order to facilitate easy data insertion, access, and update.

Claim 17: Muftic discloses that the card transaction involves a smart card (e.g., see col. 1, line 20).

Claims 18 and 19: Muftic discloses the point of service terminal is being at a retail location and transmitting information to and from a merchant service provider (e.g., see col. 4, lines 60-65).

6. Claims 4, 16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muftic (U.S. Patent No. 5,850,442) in view of Athing et al. (U.S. Patent No. 5,987,498).

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Claims 4 and 16: Muftic discloses the terminal and the method of claims 3 and 15 wherein entering additional transaction information. However, Muftic does not specifically disclose includes entering the additional transaction information using a touch sensitive screen of the transaction device. Athing discloses such step (Col. 9, line 44-col. 11, line 18, and col. 1, line 28-col. 13, line 23).

Claim 20: Muftic further discloses the step of providing an electronic signature (e.g., col. 14, line 45) without explicit disclosure of using a pen and the touch-sensitive screen. However, as shown by Athing, the use of a touch-sensitive screen is well known and the use of an electronic pen is also well known in the art. Thus, it would have been within the level of ordinary skill in the art to employ these well-known features to the method of Muftic to further facilitate a card transaction over an open network.

Response to Arguments

7. Applicant's arguments filed on September 2, 2002 have been fully considered but they are not persuasive for the following reasons:

- In response to applicant's assertion that Muftic does not disclose the transaction device which does not utilize **proprietary software of a merchant service provider** to complete the transaction (emphasis added).

Applicant's interpretation of Muftic is incorrect. More specifically, it is true that Muftic discloses the use of smart token technology software. However, the smart token technology

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software disclosed by Muftic is not the **proprietary software of a merchant service provider** (i.e., software of credit companies) but a software used for world wide electronic commerce system to enhance the security of transaction over an open network (i.e., the smart token technology software disclosed by Muftic a proprietary software of a software company which produced but not the **proprietary software of a merchant service provider.**).

- **In response to applicant's argument regarding claims 7 and 8.**

Applicant's attention is directed to the fact that the specification as originally filed does not specifically define the term "coupon". Thus, the term "coupon" in the instant application is interpreted based on Webster's Collegiate Dictionary which includes an insurance certificate is one of the coupons. *Texas Digital Systems Inc. v. Telegenix Inc.*, 64 USPQ2d 1812 (CA FC 2002)

- **In response to applicant's argument regarding claim 10.**

Contrary to applicant's assertion, Muftic clearly discloses the step of "updating the commands of the web server." For example, col 12, lines 5-40 thereof, Muftic discloses the process of registering new user and loading authentic information into a server. Of course, whenever a new user registers for the certification, the commands of the web server must be updated to allow the new user a card transaction over an open network.

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8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. Pedro R. Kanof whose telephone number is (703) 308-9552. The examiner can normally be reached on weekdays from 7:30 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Hyung S. Sough, can be reached on (703) 308-0505. The fax phone numbers for this Group are: Customer Service (703) 872-9325, Before Final (703) 872-9326, and After Final (703) 872-9327.


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.

PRK-5/17/02.



HYUNG SOUGH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600